



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/543,860	04/05/2000	Stephen Smith	200-0235	6394

33198 7590 05/05/2003

BARTON E. SHOWALTER
2001 ROSS AVENUE, 8TH FLOOR
DALLAS, TX 75201-2980

EXAMINER

HAQ, NAEEM U

ART UNIT	PAPER NUMBER
----------	--------------

3625

DATE MAILED: 05/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

SK

Office Action Summary

Application No.

09/543,860

Applicant(s)

SMITH, STEPHEN

Examiner

Naeem Haq

Art Unit

3625

— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 18 February 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 and 24-50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 and 24-50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

Art Unit: 3625

DETAILED ACTION

Response to Amendment

This action is in response to the Applicant's response, paper number 10, filed on February 18, 2003. Claims 1-22 and 24-50 are pending.

Final Rejection

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title.

Claims 1-22 and 24-50 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The invention as recited in claims 1-22 and 24-50 is merely an abstract idea that is not within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. Mere recitation in the preamble (i.e., intended use) or mere implication of employing a machine or article of manufacture to perform some or all of the recited steps does not confer statutory subject matter to an otherwise abstract idea. For example, mere nominal use of a component, albeit within the technological arts, does not confer statutory subject matter to an otherwise abstract idea

if the component does not affect or effect the underlying process. Moreover, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case, claims 1-22 and 24-30 are directed to an article of manufacture namely a schema comprising a search request message, a search reply message, and a tag request message. Please note that a schema is nothing more than an abstract representation of data. As such the limitations of the claim do not produce a useful, concrete, and tangible result even if embodied on a tangible medium. Therefore, claims 1-22 and 24-30 recite inoperative, non-functional descriptive material and are analyzed as non-statutory subject matter under examination guidelines as per MPEP 2106.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 17, 31, and 45 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. These claims recite the limitation "...a first dealer identifier of a first dealer having the tagged vehicle in inventory and a second dealer identifier of a second dealer selected by the user from

whom to purchase the tagged vehicle in the first dealer's inventory." There is no support for the limitation "...in the first dealer's inventory."

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 2-9, 11, 12, 15-22, 25, 26, 29-37, 39, 40, and 43-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wolfe et al (US 6,282,517 B1) in view of Tittel et al "XML for Dummies".

Referring to claims 1, 17, 31, and 45, Wolfe teaches an online system, comprising:

- generating a search request message including at least one search criteria (column 6, lines 31-33; column 10, lines 19-24) and a weighting of each criterion (column 4, lines 57-65; column 8, lines 6-21);
- generating a search reply message in response to processing the search request message, the search reply message including a list of products matching at least one search criteria including: a list of vehicles matching the at least one search criteria (Figure 15), and a plurality of vehicle configuration parameters of the vehicles matching at least one search criteria, including vehicle identifier, make, model, dealer identifier, price, and color (Figures 3, 4, and 15).

Referring to claims 2, 32, 33, and 47, Wolfe teaches all of the limitations of claims 1, 31, and 45 as noted above. Wolfe does not teach that the search request and reply messages are in XML. However, Tittel teaches the benefits of incorporating XML into an HTML document (pages 27-42). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, incorporate the teachings of Tittel into the system of Wolfe. One of ordinary skill in the art would have been motivated to do so in order to gain all of the advantages offered by XML as taught by Tittel.

Referring to claim 3, Wolfe teaches that the search request message comprises: a request tag, a criteria tag, and a criterion tag providing a dealer identifier (column 4, lines 57-65; column 10, lines 15-29; column 11, lines 1-8).

Referring to claims 4 and 18, Wolfe teaches all the limitations of claims 3 and 17 as noted above. Wolfe does not explicitly teach that the criterion tag provides an enumeration of a plurality of attributes each specifying a vehicle configuration parameter, including make, model, year, a close criterion tag, a close criteria tag, and a request tag. However, Wolfe teaches that his system "...guides the user in entering the necessary data to create and submit either a new vehicle purchase request or a used vehicle purchase request." (column 10, lines 20-22). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate various configuration parameters into the system of Wolfe. One of ordinary skill in the art would have been motivated to do so in order to allow a user to create a purchase request for a specific vehicle.

Referring to claims 5 and 19, Wolfe teaches a weight attribute indicate of a search weighting of the criterion (column 4, lines 57-65; column 8, lines 6-21). Wolfe does not teach a requirement attribute indicative of whether the criterion is required. However, Official Notice is taken that it is well known in the art to require a user to enter a criterion in an online shopping environment. One of ordinary skill in the art would have been motivated to do so in order to ensure that a customer had a valid license, e-mail, address, or sufficient resources to complete a transaction.

Referring to claims 6-8, 20-22, and 34-36, Wolfe teaches the system of claims 1, 17, and 31, wherein a vehicle parameter of the search reply message comprises: a vehicle status; a list of configured model parameters, including: a price, a make, a model, a dealer identifier, an engine specification, a transmission specification, an exterior paint color, a wheel specification, a seat fabric specification, an interior color, and an audio system specification (Figure 15; column 10, lines 15-29). Wolfe does not explicitly teach that the reply message comprises: a vehicle identifier, a tire specification, a drive specification, a cab specification, a body style specification, a real axle ratio specification, a pay load package specification, a wheel base specification, a roof color, a door specification, an accent color, a spare tire specification, a PEP specification, an option package specification, and a stand alone package specification. However, it would have obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate all of this information into the system of Wolfe. One of ordinary skill in the art would have been motivated to do so in order to provide a customer with a complete description of the vehicle as well as all of the available

options and the convenience of referencing the vehicle by a unique vehicle identifier when contacting the dealer.

Referring to claims 9, and 37, Wolfe teaches the system of claims 1 and 17, further comprising: a tag request message including: order information associated with the tag request; contact information of the user; credit authorization information; tagged vehicle parameters (column 11, lines 9-33).

Referring to claims 11, 25, and 39, Wolfe teaches the system of claims 9, 23, and 37 as noted above. Furthermore, Wolfe teaches a customer identifier, a customer name, a customer address, a customer email address; and a specification of a best way to contact the customer (Figure 7, item 722; column 11, lines 9-33). Wolfe does not explicitly teach a customer daytime telephone number, a customer evening telephone number, and a customer facsimile number. However, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate this information into the system of Wolfe. One of ordinary skill in the art would have been motivated to do so in order to provide a car dealer with a plurality of ways of contacting a potential customer.

Referring to claims 12, 26, and 40, Wolfe teaches the limitations of claims 9, 23, and 37 as noted above. Wolfe does not explicitly teach that the credit card authorization information comprises a credit card authorization number. However, Official Notice is taken that it is well known in the art for a consumer to provide a credit card number in an online shopping environment. One of ordinary skill in the art would have been motivated to do so in order to facilitate an electronic transaction.

Referring to claims 15, 29, and 43, Wolfe teaches a tag status message generated in response to processing a tag request message (Figure 15).

Referring to claims 16, 30, and 44, Wolfe does not teach all the information enumerated by the applicant. However, please note that it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate any information into the web page of Wolfe. One of ordinary skill in the art would have been motivated to do so in order to provide a customer with a complete description of a vehicle.

Referring to claims 46, 48, and 50, Wolfe teaches the limitations of claim 45 as noted above. Furthermore Wolfe teaches that the search reply message comprises compiling a list of products and respective configuration data (Figures 14, 15, and 16). Wolfe does not teach providing a percentage value for each product in the list indicative of the degree of match between the product and the configuration data contained in the search request message. However, Official Notice is taken that it is well known in the art to provide a search result with a percentage value for each product in a list indicative of the degree of match between the product and the data contained in a search request. Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate a percentage value into the system of Wolfe. One of ordinary skill in the art would have been motivated to do so in order to allow a user to see which products closely matched his or her search request.

Referring to claim 49, Wolfe teaches importing in-inventory product availability data from dealerships, and importing in-process product availability data

from an enterprise database (column 7, lines 1-9; column 9, lines 41-47; column 12, lines 40-49).

Claims 13, 14, 27, 28, 41, and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wolfe et al (US Patent 6,282,517 B1) in view of Korth et al "Database System Concepts".

Referring to claim 13, 27, and 41, Wolfe teaches the limitations of claims 1, 17, and 31 as noted above. Furthermore, Wolfe teaches a stock number, a plurality of vehicle configuration parameters, a dealer identifier, an initial status indicative of whether the vehicle is new or used, and a search identifier specifying the selected vehicle configuration (Figures 5, 7, and 8; column 9, lines 49-60; column 11, lines 9-33, lines 43-57). Wolfe does not explicitly teach a vehicle identifier. However, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate a vehicle identifier into the system of Wolfe. One of ordinary skill in the art would have been motivated to do so in order to provide a customer with the convenience of contacting the dealer directly and referencing the vehicle by a unique vehicle identifier. Wolfe also does not teach an item number or an order line number. However, Korth teaches a system for managing records in a database that includes a superkey for uniquely identifying an entity in an entity set (page 30-31). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Korth into the system of Wolfe. One of ordinary skill in the art would have been motivated to do so in order to uniquely identify an entity in entity set by its attributes.

Referring to claims 14, 28, and 42, Wolfe and Korth do not explicitly teach that the vehicle configuration parameters comprises: a tire specification, a drive specification, a cab specification, a body style specification, a real axle ratio specification, a pay load package specification, a wheel base specification, a roof color, a door specification, an accent color, a spare tire specification, a PEP specification, an option package specification, and a stand alone package specification. However, it would have obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate all of this information into the system of Wolfe and Korth. One of ordinary skill in the art would have been motivated to do so in order to provide a customer with a complete description of the vehicle as well as all of the available options and the convenience of referencing the vehicle by a unique vehicle identifier when contacting the dealer.

Claims 10, 24, and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wolfe et al (US Patent 6,282,517 B1) in view of St. Laurent "Cookies".

Wolfe teaches all the limitations of claims 9, 23, and 37 as noted above. Wolfe also teaches that the order information comprises: an order number, an order total price, an order date, an order time, a dealer identifier, and a payment method (Figures 7, items 702, 706, and 726; Figure 8, items 806 and 820; Figures 15 and 17). Wolfe does not teach a deposit amount. However, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to include a deposit amount into the system of Wolfe. One of ordinary skill in the art would have been

Art Unit: 3625

motivated to do so in order to allow a customer to reserve a vehicle. Wolfe also does not teach a source identifier associated with the web site from which the tag request originated, or a session identifier of the online session during which the tag request was submitted. However, St. Laurent teaches the use of cookies as a source and session identifier in an online environment (page 2). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of St. Laurent into the system of Wolfe. One of ordinary skill in the art would have been motivated to do so in order to maintain state in an online environment, as taught by St. Laurent.

Response to Arguments

Applicant's arguments filed February 6, 2002 have been fully considered but they are not persuasive.

Referring to the Examiner's rejection under 35 USC 101, the Applicant has argued that the invention is statutory because the claims are directed to an "online vehicle ordering and tracking system." Please note that this limitation is recited only in the preamble of the claims. A preamble is generally accorded very little weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Furthermore, the Examiner notes that even if this

limitation were incorporated into the body of the claim, the invention would still be non-statutory since the invention is directed a "schema". As noted above under the 35 USC 101 analysis, a schema is nothing more than an abstract representation of data. All that is necessary to make a sequence of operational steps a statutory process within 35 U.S.C. 101 is that it be in the technological arts so as to be in consonance with the Constitutional purpose to promote the progress of "useful arts." *In re Musgrave*, 431 F.2d 882, 167 USPQ 280 (CCPA 1970). A claim is limited to a practical application when the method, as claimed, produces a concrete, tangible and useful result: i.e. the method recites a step or act of producing something that is concrete, tangible and useful. See *AT&T v. Excel Communications Inc.*, 172 F.3d at 1358, 50 USPQ2d at 1452. A machine claim is statutory when the machine, as claimed, produces a concrete, tangible and useful result. See *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 149 F.3d at 1373, 47 USPQ2d at 1601 (Fed. Cir. 1998). For these reasons, the Examiner maintains the rejection under 35 USC 101.

Referring to the Examiner's rejection under 112, first paragraph, the Applicant has not pointed where in the specification the limitation "...in the first dealer's inventory" is properly supported. For this reason, the Examiner maintains this rejection.

Referring to the Examiner's rejection under 112, second paragraph, this rejection is hereby withdrawn.

Referring to the Examiner's 103 rejection, the Applicant argues that Wolfe does not teach the limitation "the tagged vehicle parameters including a vehicle identifier, a first dealer identifier of a first dealer having the tagged vehicle in inventory and a second

Art Unit: 3625

dealer identifier of second dealer selected by the user from whom to purchase the tagged vehicle in the first dealer's inventory." The Examiner respectfully disagrees. Wolfe explicitly teaches a vehicle parameter including a vehicle identifier, a first dealer identifier of a first dealer having the tagged vehicle in inventory (Figure 5; column 9, lines 49-60). Furthermore, Wolfe teaches that his system identifies an appropriate seller (dealer) from the information entered by the user (column 3, lines 5-13). Specifically, Wolfe teaches that the buyer uses a zip code to identify and locate potential sellers (column 4, lines 65 – column 5, lines 1-9; column 7, lines 60-65; column 12, lines 20-39). Finally, Wolfe states, "...the buyer may specify one or a plurality of dealers to receive the purchase request." (column 13, lines 8-11). For these reasons, the Examiner maintains the art rejection.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

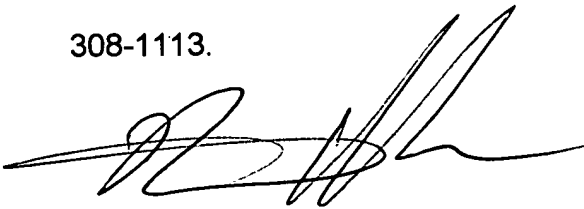
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naeem Haq whose telephone number is (703)-305-3930. The examiner can normally be reached on M-F 8:00am-5:00pm.

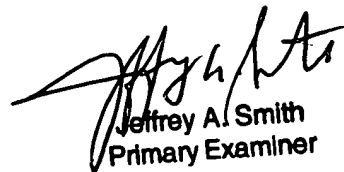
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on (703)-308-1344. The fax phone numbers for the organization where this application or proceeding is assigned are (703)-305-7687 for regular communications and (703)-305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)-308-1113.



Naeem Haq, Patent Examiner
Art Unit 3625

April 30, 2003



Jeffrey A. Smith
Primary Examiner